

Amendment and Response

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Serial No.: 10/009,603

Confirmation No.: 4201

Filed: 11 December 2001

For: SUPPORT MATERIALS AND IMAGING METHOD FOR INTRAORAL DIAGNOSTIC PURPOSES

Remarks

The Final Office Action mailed 8 February 2006 has been received and reviewed. No claims having been canceled, amended, or added herein, the pending claims are claims 17 and 19-47. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowed Claims

Applicants thank the Examiner for noting that claims 17 and 19-46 have been allowed.

Rejection under 35 U.S.C. §102

The Examiner rejected claim 47 under 35 U.S.C. §102(b) as being anticipated by Kokal, Jr. (U.S. Patent No. 3,959,881). This rejection is respectfully traversed.

"[F]or anticipation under 35 U.S.C. 102, the reference must teach *every aspect* of the claimed invention either explicitly or impliedly." M.P.E.P. §706.02 (emphasis added).

Claim 47 recites a composition that "presents the diagnostic result by signal development in or upon the surface of the support material or by binding of a detectable agent to the support material." Kokal, Jr. provides no disclosure or suggestion of such a composition that presents a diagnostic result *in or upon the surface of the support material*. In contrast, as noted in the Amendment and Response submitted 23 November 2005, a careful reading of Kokal, Jr. shows that the diagnostic image is formed *on the teeth* of the subject (e.g., column 3, lines 6-8).

Thus, Kokal, Jr. fails to anticipate present claim 47.

Nonetheless, the Examiner responded by stating his position "that the Kokal 'support material' is a paper and that the ruptured ink or dye microcapsules within the paper would stain and mark the surface of the paper just as ink marks the paper of this page. Whether some of the Kobal (*sic.*) ink/dye is capable of also marking the user's teeth is not pertinent to what is required by the claim" (paragraph spanning pages 2-3 of the Office Action mailed 8 February 2006). Applicants earnestly disagree with the Examiner's position.

First, the Examiner has failed to provide any support for his position. In the event that this rejection is maintained, the Examiner is requested to provide full support for his stated position.

Second, Kokal, Jr. provides absolutely no disclosure or suggestion that the ruptured ink or dye microcapsules within the paper would stain and mark the surface of the paper as suggested by the Examiner. In contrast, Kokal recites that "a primary object of the present invention to provide a novel and unique apparatus which enables the *premature contact points* on occlusion to be marked" (column 1, lines 46-49; emphasis added) and that "[a]n additional object of the present invention is to provide apparatus for marking *tooth contact points*" (column 1, lines 57-58; emphasis added). If the inks or dyes were to stain the paper instead of staining the tooth contact points, objects of the invention would be defeated.

Finally, to the extent that the Examiner is inferring that the paper would *inherently* be stained by the inks or dyes, Applicants again disagree. Applicants respectfully submit that the Examiner has failed to show that the paper would *necessarily* be stained by the inks or dyes. Further, Applicants can suggest a variety of reasons why the paper might not be stained by the inks or dyes. For example, in some embodiments disclosed by Kokal, Jr., the inks or dyes can be "encased by a membrane" (column 2, line 55). Such a membrane might prevent the ink or dye from staining the paper. For another example, the paper might be colored (e.g., by the ink or dye) before the apparatus is used to detect articulation. In this case, articulation might not leave a visible mark on the paper. For even another example, the paper might have properties (e.g., hydrophilicity and/or hydrophobicity, acidity and/or alkalinity) that could prevent the ink or dye from staining the paper.

For at least these reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation of claim 47 by Kokal, Jr. Reconsideration and withdrawal of the rejection under 35 U.S.C. §102 are respectfully requested.

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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CERTIFICATE UNDER 37 CFR §1.8:

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I hereby certify that the Transmittal Letter and the paper(s) and/or fee(s), as described hereinabove, are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to: **Mail Stop RCE**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: 

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